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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,299	07/18/2003	Arvind N. Shah	679.0044USU	7273

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EXAMINER	
KANTAMNENI, SHOBHA	
ART UNIT	**PAPER NUMBER**
1617	

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/622,299	SHAH ET AL.	
	Examiner	Art Unit	
	Shobha Kantamneni	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *NONE* is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *02/11/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This application was filed on 07/18/2003, which claims priority from U.S. provisional application Serial No. 60/397,291 filed on 07/19/2002.

Claims 1-20 are pending, and examined herein.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-19 are rejected under 35 U.S.C. 112, second paragraph, as being vague for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation "shade-matching a pearlescent component to a natural skin tone benchmark shade to form a shade-matched pearlescent component" is vague as it is not clear as to the method steps used to form a shade-matched pearlescent component. It is not clear if the shade-matched pearlescent component contains just a pearlescent ingredient such as bismuth oxychloride or other ingredients are added to the pearlescent ingredient to form a "shade-matched pearlescent component".

Claim 20 is further rejected under 35 U.S.C. 112, second paragraph, as being vague for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation "desired skin color" in claim 20, line 3 is vague because it is subjective.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-14, 16-20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for pearlescent component such as bismuth oxychloride, **does not reasonably provide enablement for <u>any</u>** pearlescent component **<u>in general</u> that is matched to a natural skin tone bench mark shade.** The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention **commensurate in scope** with these claims.

The instant specification fails to provide information that would allow the skilled artisan to practice the instant invention without **undue experimentation**. Attention is directed to *In re Wands*, 8 USPQ2d 1400 (CAFC 1988) at 1404 where the court set forth the eight factors to consider when assessing if a disclosure would have required undue experimentation. Citing *Ex parte Forman*, 230 USPQ 546 (BdApls 1986) at 547 the court recited eight factors:

(1) the nature of the invention; (2) the state of the prior art; (3) the relative skill of those in the art; (4) the predictability or unpredictability of the art; (5) the breadth of the

claims; (6) the amount of direction or guidance presented; (7) the presence or absence of working examples; and (8) the quantity of experimentation necessary.

(1). The Nature of the Invention:

All of the rejected claims are drawn to an invention which pertains to a composition comprising a pearlescent component that is matched to a natural skin tone benchmark shade. The nature of the invention is complex in that it encompasses **any** pearlescent component, which is matched to a natural skin tone benchmark shade.

(2). Breadth of the Claims:

The complex nature of the subject matter of this invention is greatly exacerbated by the breadth of the claims. The claims encompass composition comprising **any compounds or substances represented by "pearlescent component.."**

(3). Guidance of the Specification / (4) Working Examples:

Applicant describes a pearlescent component as any shade-matched pearlescent component which may include "color-based pearls or any combinations thereof" on page 12, lines 21-23, and recites preferable pearlescent component has a bismuth oxychloride based pearlescent ingredient or reflectance pearls on page 13, lines 1-14.

However, the specification does not provide any example with a pearlescent component that is matched to a natural skin tone benchmark shade other than reciting that the "The pearlescent component preferably has a bismuth oxychloride-based pearlescent ingredient", on page 8, lines 7-10 of the instant specification.

(5). State of the Art:

While the state of the art is relatively high with regard to specific pearlescent component in the composition, the state of the art with regard to **any** pearlescent component in **general** is underdeveloped. Different pearlescent components have different chemical structures, physical properties such as optics of light absorption, reflection and scattering, and are expected to behave in different manners, evidence that the level of skill in this art is low relative to the difficulty of the task of determining a suitable pearlescent component.

(6). Predictabilitv of the Art:

The invention is directed to pearlescent component **broadly** in the composition. It is well established that "the scope of enablement various inversely with the degree of unpredictability of the factors involved".

For example the instant specification on page 14, discloses that " Other pearls are white nacreous materials, such as mica covered with titanium oxide or covered with bismuth oxychloride; and colored nacreous materials, such as titanium mica with iron oxides, titanium mica with ferric blue or chromium oxide, titanium mica with an organic pigment the aforementioned type. However, these other materials sometimes lend a white, chalky, ashy appearance to the skin when the final composition is applied to the skin, and thus these materials are preferably not used in the present invention."

Thus, the types of pearlescent components that can be used in the composition in instant claimed invention is highly unpredictable.

(7). The Quantitv of Experimentation Necessary:

In order to practice the claimed invention, one of skill in the art would have to first envision a specific pearlescent component, amount of the pearlescent component, choose a pigment, and the amount of pigment etc. One of skill in the art would then need to make the final composition for specific application to the skin, and then test the appearance of the skin. If when applied to the skin the appearance is not acceptable for the chosen pearlescent component, one of skill in the art would have to modify the pearlescent component, pigment and other ingredients, and amounts of each ingredient. This experimentation has to be performed with each pearlescent component because the claimed pearlescent components will have different physical properties such as reflectance and will interact differently with the other components. Thus the claims currently encompass **any pearlescent component in general** that is matched to a natural skin tone benchmark shade combined with pigment component. However, the skilled artisan clearly would have to undertake trail and error process to determine which of the claimed pearlescent component should be combined with the multitude of claimed pigments, as well as the multitude of claimed pearlescent components. Such a trial and error process clearly amounts to undue experimentation.

Further, this recitation "pearlescent component" may broadly encompass those known and **unknown** compounds having the recited functions as of the instant filing date, as discussed above. Note those **future known** compounds yet to be discovered and/or made. Hence, those unknown or future known compounds encompassed by claims herein must require to additional or future research to discover, establish or

verify their usefulness. Therefore, as indicated above the skilled artisan has to exercise **undue experimentation** to practice the instant invention.

Genetech, 108 F.3d at 1366 states that "a patent is not a hunting license. It is not a reward for search, but compensation for its successful conclusion" and "[p]atent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12, 14-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Brieva et al. (US 5,800,816, PTO-892).

Brieva et al. disclose compositions for topical application to skin comprising a pearlescent component bismuth oxychloride, and organic pigments including D&C and FD&C blues, browns, greens, oranges, reds, yellows, etc. and inorganic pigments including iron oxides, ultramarine, and chromium or chromium hydroxide colors, etc. See column 4, lines 45-55, lines 59-60; column 5, lines 14-23; column 6, lines 65-column 7, line 5. Pearlescent component, and pigments are present in an amount of 0. 1 to 70 % by weight. See column 4, line 48. The composition is incorporated into a

vehicle which is a color cosmetic composition such as lipstick, powder, blush, eyeshadow, liquid or powder, makeup. See column 4, lines 52-55. It is further disclosed that the composition can be in the form of oil emulsion makeup compositions. See column 6, lines 5-7. A method of making water in silicone emulsion make up composition comprising silicone polymer, cyclomethiocone/dimethicone copolyol; pearlescent ingredient, mica; pigments such as red iron oxide, yellow iron oxide, and water is also disclosed. See EXAMPLE 1, column 7, lines 43-55; column 8, EXAMPLE 5. An eyeshadow formulation comprising Bismuth oxychloride, pigments such as black, yellow, red iron oxides is disclosed in EXAMLE 5, column 9. The composition can comprise from about 0.1-60 % of volatile components which include straight or branched chain hydrocarbons such as isododecane. See column 2, lines 44-46; EXAMPLE 2.

The recitation "pearlescent component that is matched to a natural skin tone benchmark shade" in claim 1, is inherent property of bismuth oxychloride which matches the skin's natural pearlescence.

Thus, Brieva et al. anticipate instant claims 1-12, and 14-20.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-10, 13, 14-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Tan et al (US 6,511,672, PTO-892).

Tan et al. disclose cosmetic composition for topical application to skin comprising a platelet, bismuth oxychloride, and a pigment. It is further disclosed that the combination of platelets and pigments creates a mosaic of color and optically manipulates light such that the lines, wrinkles, disfigurations and discolorations on the skin appear to substantially vanish and the net effect is the skin appears natural, luminous and flawless. See abstract; column 4, lines 20-21; column 6, lines 15-49; column 8, claims 1,3. Inorganic pigments, and organic pigments are used in the composition. The platelet comprising bismuth oxychloride is present in an amount of 0.1 to 10.0 %, and the pigments are present in an amount of 0.05 to 50 % by weight. See column 4, lines 33-35; column 5, lines 12-15. It is also disclosed that the composition formed by blending pigment and bismuth oxychloride can be used in any type of skin treatment or makeup product. The makeup products include foundations, blushes, pressed or loose powders, concealers, bronzers, lipsticks, lipglosses. Also the products can be in the form of gels, sticks, water-in oil emulsions, sprays, pressed or loose powders. See column 6, lines 59-66. For liquid foundation a water-in-oil emulsion is preferred, and the oil component comprises a silicone oil. See column 7, lines 4-9; column 8, EXAMPLE 1. Tan et al. also discloses that the pigment is blended with the pearlescent to closely match the natural skin tone. See column 3, lines 56-60.

Thus, Tan et al. anticipates instant claims 1-10, 13, 14-20.

Claims 1-9, and 14-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Simon et al (US 6,372,202, PTO-1449).

Simon discloses a colored cosmetic compositions for topical application comprising pearlescent agents, such as mica covered with bismuth oxychloride, and pigments. See column 7, lines 38-44; See column 9, EXAMPLE 2 wherein the composition comprises 8 % of bismuth oxychloride, and 5 % of pigment. The composition can be in the form of water in oil emulsion. See column 5, lines 60-63. The composition can be in the form of nail varnish, mascara, eyeliner, lipstick, lip gloss, foundation, powder etc. See column 14, claims 1, 29. A method of preparing the cosmetic composition using pearlescent component bismuth oxychloride is also disclosed. See column 9, lines 30-55.

Thus, Simon et al. anticipates instant claims 1-9, and 14-20.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shobha Kantamneni whose telephone number is 571-272-2930.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shobha Kantamneni
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Art Unit 1617

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